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REMARKS

Applicant has carefully studied the Office Action of June 2, 2003 and offers the following remarks in response thereto.

Claim 1 is amended to correct a typographical error. This amendment does not change the scope of the claim, nor raise new issues.

Double Patenting

Applicant acknowledges the provisional double patenting rejection in light of co-pending application Serial No. 09/611,087. As no patent has issued, this rejection remains provisional. Applicant reserves the right to determine which patent application should mature to a patent first and will file the appropriate terminal disclaimer in the other application after the first patent issues.

§ 103**Claims 1-7, 10-16, 27, and 29-38**

Claims 1-7, 10-16, 27, and 29-38 were rejected under 35 U.S.C. § 103 as being unpatentable over Kirouac et al. (hereinafter "Kirouac") in view of Finley et al. (hereinafter "Finley"). Applicant respectfully traverses. For the Patent Office to establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is present within the combination of references. MPEP § 2143.03. If the Patent Office cannot do so, Applicant does not have to come forward with evidence of non-obviousness. Further, the Patent Office is not entitled to extract selective portions of the references in constructing an obviousness rejection. The references must be considered in their entireties. MPEP § 2141.02.

When Kirouac is considered in its entirety, it is clear that Kirouac would not be combined with the portable computing device of Finley. Specifically, in the Background section, Kirouac argues that intermediate devices (such as floppy disks and tapes) are an undesirable method of distributing software (see Kirouac, column 1, lines 11-51). In contrast to techniques that use intermediate devices, Kirouac introduces a system by which remote computers access a central computer and receive downloads therefrom. Thus, when the Patent Office says that it would it would have been obvious to modify Kirouac with the remote computers of Finley, the Patent Office is overlooking the fact that Kirouac discourages the introduction of such an intermediate

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media. The motivation offered by the Patent Office to make the combination "to use available means" (Office Action, page 10, lines 8-9) is not compelling enough to overcome the fact that Kirouac teaches away from the introduction of such an intermediate device. Applicant reminds the Patent Office that merely because references can be combined does not mean that the combination is obvious. MPEP § 2143.01.

In short, the combination of Kirouac and Finley is based on impermissible hindsight reconstruction. There is no motivation to combine the references in the manner advanced by the Patent Office. Since the references are not properly combinable, and the Patent Office admits that Kirouac does not teach or suggest all the claim elements, the rejection on Kirouac alone does not show all the claim elements and the claims are patentable over Kirouac.

Claims 8, 9, 17-26, and 28

Claims 8, 9, 17-26, and 28 were rejected under 35 U.S.C. § 103 as being unpatentable over Kirouac in view of Finley and further in view of Fisher et al. (hereinafter "Fisher"). Applicant respectfully traverses. The standard for proving obviousness is set forth above.

The rejection is based on the combination of Kirouac and Finley, which, as discussed above, is improper. Further, Fisher is non-analogous art. Applicant's field of endeavor is the provision of software upgrades to fueling environments. In contrast, Fisher is concerned with the pre-installation of software on newly built computers (see Fisher, *inter alia* column 1, lines 14-18 and 58). Thus, Fisher is not in the same area as Applicant. Nor does Fisher logically commend itself to an inventor's attention when considering the problem of downloading software to a fueling environment. There is no logical reason why someone looking to update software in a fueling environment would look to how software is pre-installed on newly built machines. To this extent, Fisher is non-analogous art. Since Fisher is non-analogous art, it cannot be used to support an obviousness rejection. Since Fisher is unavailable to support the rejection, the accounting element of the claims is not shown or suggested, providing an independent reason why claims 8, 9, 17-26, and 28 are patentable.

Conclusion


Applicant requests reconsideration of the rejections based on the arguments presented herein. Specifically, the combination of references of record is improper and the remaining

reference does not teach or suggest every claim element, and thus, the Patent Office has not established *prima facie* obviousness. In light of the failure of the Patent Office to establish *prima facie* obviousness, Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By:


Steven N. Terranova
Registration No. 43,185
P.O. Box 1287
Cary, NC 27512
Telephone: (919) 654-4520

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